

### REMARKS

This Amendment and Response is presented together with an Request for Continued Examination filed in response to the Final Office Action dated November 29, 2004, in the matter of U.S. Patent Application No. 10/084,266, and consideration is respectfully requested.

In response to a Restriction Requirement, the Applicants traversed the Restriction Requirement and elected Claims 20-23. The Examiner upheld the Restriction Requirement, and thus, Claims 1-19 and 24-28 are withdrawn from consideration by the Examiner. In an Amendment and Response filed September 3, 2004, the Applicants cancelled previously elected Claims 20-23 and added Claims 29-39. In the November 29, 2004 Office Action, the Examiner withdrew Claims 32-39 as being drawn to a non-elected invention, and rejected Claims 29-31.

In the Amendment and Response presented herewith, Applicants have added new Claims 40-55. New Claims 40-55 correspond with originally-filed Claims 20-23 (now canceled), with some limitations removed and additional limitations added. Applicants submit that new Claims 40-55 pertain to the same invention as previously elected Claims 20-23. Applicants have cancelled Claims 1-39.

Support for the Claim amendments presented herein can be found in the Specification, for example, p. 16 ll. 4-5; p. 18, l. 9 through p. 20, ll. 24; p. 22 ll. 1-7; and Figures 1-2.

#### Rejection under 35 U.S.C. § 102(b)

##### Schmoock, U.S. 5,344,692

The Examiner has rejected Claims 29-31 under 35 U.S.C. § 102(b) over Schmoock. The Examiner asserts that Schmoock teaches two members bonded with a hot melt adhesive wherein the first member has at least one thinner portion than the rest of the first member, and refers to Figs 1 and 3 showing a leather member with a profiled surface (i.e. some portions are thinner than others) bonded to a resin layer using a hot melt adhesive. Although Applicants have canceled Claims 29-31, Applicants submit that Claims 40-55 are directed to the same invention as canceled Claims 29-31 as well as canceled Claims 20-23 and therefore direct their remarks towards Claims 40-55.

Applicants traverse this rejection. It is well recognized that claims are anticipated if, and only if, each and every element, as set forth in the claim is found in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the...claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). See MPEP §2131.

Schmoock is directed to flexible laminates where at least one side of a substrate of leather is provided with a laminate coating. Col. 1, ll. 11-20. Specifically, a thermoplastic layer, which can include a hot melt adhesive, is applied to the leather serving as a means for filling in unevenness of the leather substrate and an outer layer which can be smoothed, embossed or otherwise processed to provide a particular appearance and is composed of a polymer resin. In particular, Schmoock's article teaches a flexible laminate with a substrate layer, hotmelt layer, and polymer resin outer layer that is continuous and unbroken. See Figs 1-3.

In contrast, the present invention as claimed in Claim 40 contains a first limitation directed to a leather where "at least a portion of said first member is not in contact with said second member," in contrast to Schmoock, which discloses a substrate layer, hotmelt layer, and polymer resin outer layer that is continuous and unbroken. Further, Claim 40 contains the limitation that "the portion of said first member contacting said second member is thinner in thickness than the portion of said first member not contacting said second member." This limitation is directed to the property of the leather article of the present invention where the first member (leather) is thinner only where it is in contact with the second member. This is due to the transmutation introduced during the process of making the leather, where a waterproof coating from a first member is removed and/or melted during a step where heat is applied only to the portion of the first member and the second member in contact with one another. In contrast, the variation in thickness seen in the leather substrate of Schmoock is due merely to natural variations in the leather substrate, and therefore, is thinner in random locations, i.e., it is not thinner merely where it is in contact with the second member.

Claim 41, a dependent from Claim 40, contains the additional limitation wherein the first member has a waterproof coating. Schmoock teaches the use of skins or leather substrates but does not disclose use of substrates already containing waterproof coatings. See Col. 9 ll. 14-17.

Claim 42, a dependent from Claim 41, contains the additional limitation that "the waterproof coating of the part or portion of said first member in contact with said second member is transmuted or removed at least partially in the direction of thickness of the first member and the waterproof

coating on part or portion of said first member not in contact with said second member is not transmuted or removed at least partially.” This is due to the transmutation introduced during the process of making the leather article, where a waterproof coating from a first member is removed and/or melted during a step where heat is applied only to the portion of the first member and the second member in contact with one another. Accordingly, the waterproof coating of the first member is transmuted only where the second member is in contact with the first member. In contrast, Schmooch does not disclose a leather with a waterproof coating nor does Schmooch disclose transmutation of said coating only where the second member is in contact with the first member.

With regard to Claim 43, a dependent from Claim 41, this claim contains a limitation that the part or portion of said first member not in contact with said second member has no change in quality due to heat. In contrast, Schmooch teaches a heating element 24 in Figure 4 that supplies the necessary temperature (disclosed to be 120°C or above) over the entire flexible laminate assembly. See Col. 11, ll. 4-10. Accordingly, the entire flexible laminate including the leather substrate is exposed to heat and has its quality changed. In contrast, in the present invention, heat is only applied to the portions of the first member which are in contact with the second member, resulting in at least a portion of the first member which has not been exposed to heat and therefore, has not had its quality changed.

The remainder of Claims 44-55 present the above-discussed limitations in several different variations. Therefore, Applicants apply the arguments made above to Claims 40-43 to Claims 44-45. Accordingly, Schmooch does not teach all the limitations of Claims 40-55 and Applicants respectfully request withdrawal of this rejection.

JP 06-184891

The Examiner has rejected Claims 29-31 under 35 U.S.C. § 102(b) over JP 06-184891 for the reason that Schmooch teaches two members bonded with a hot melt adhesive wherein the first member has at least one thinner portion than the rest of the first member, and specifically refers to JP 06-184891's teaching of a first decorative resin object layer containing a concave profile (i.e., one part is thinner than the other) with a hot melt adhesive thereon which is used to bond this structure to a cloth covering. Although Applicants have canceled Claims 29-31, Applicants submit that

Claims 40-55 are directed to the same invention as canceled Claims 29-31 as well as canceled Claims 20-23 and therefore direct their remarks towards Claims 40-55.

Applicants note that JP 06-184891 teaches in Drawings 6-9 a decorative object (corresponding with the present invention's second member) having a thinner portion adapted for placement of hot melt adhesive. Claim 40's limitation that "the portion of said first member contacting said second member is thinner in thickness than the portion of said first member not contacting said second member" is not taught by JP 06-184891. The present invention is distinguished from the reference in that the thinner portion in Claim 40 of the present invention is the first member, not the second member (corresponding to the references' decorative object.) JP 06-184891 does not teach that the first member has thinner portions nor does it teach that the thinner portions are only the portions in contact with the second member. Further, JP 06-184891 does not disclose that the article is a leather article.

Claim 41, a dependent from Claim 40, contains the additional limitation wherein the first member has a waterproof coating. JP 06-184891 does not teach use of skins or leather as the first member, neither does it teach using a first member with a waterproof coating.

Claim 42, a dependent from Claim 41, contains the additional limitation directed to the waterproof coating of a first member being transmuted and removed where the first member and the second member are in contact, but not where the members are not in contact. JP 06-184891 does not disclose such transmutation of a waterproof coating, and further does not disclose such transmutation only where the first and second member are in contact.

With regard to Claim 43, a dependent from Claim 41, this claim contains a limitation that the part or portion of said first member not in contact with said second member has no change in quality due to heat. In contrast, JP 06-184891 teaches heating the rear face side of a covering sheet (corresponding to the present inventions' first member, the side opposite of the second members' attachment), where the front face side of the covering sheet faces the rear face side of the decorative object. (Paragraph 0010). Accordingly, the heat is applied to the covering sheet over the portions that are in contact with the decorative objects as well parts of the covering sheet not in contact with the decorative object, causing quality change due to heat on both sections of the covering sheet. In contrast, in the present invention, heat is only applied to the portions of the first member which are

in contact with the second member, resulting in at least a portion of the first member which has not been exposed to heat and therefore, has not had its quality changed.

The remainder of Claims 44-55 present the above-discussed limitations in several different variations. Applicants therefore apply the arguments made above to Claims 40-43 to Claims 44-45. Accordingly, JP 06-184891 does not teach all the limitations of Claims 40-55 and Applicants respectfully request withdrawal of this rejection.

Clarification of Japanese Patent No. 3530979

In response to the Examiner's request to clarify the pertinency of the reference JP No. 3530979, Applicants have, with this present Amendment and Response, provided an Information Disclosure Statement disclosing the patent application from which Japanese Patent No. 3530979 issued, JP No. 2001-50629. Applicants note that the present invention claims priority under 35 U.S.C. § 119 to JP No. 2001-50629, filed February 26, 2001; Applicants submit that JP 353079 is an issued patent from JP No. 2001-50629. Applicants also submit an English-language abstract of JP 3530979 containing an English-language abstract as well as priority and application information.

Based upon the foregoing, Applicants believe that the new claims presented herein are in condition for allowance and such disposition is respectfully requested. In the event that a telephone conversation would further prosecution and/or expedite allowance, the Examiner is invited to contact the undersigned.

Respectfully submitted,

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